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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/766,513	01/19/01	PATTERSON	J P-1754

CHARLES J. PRESCOTT
CHARLES J. PRESCOTT, P.A.
SUITE 115
2033 WOOD STREET
SARASOTA FL 34237-7926

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EXAMINER

CHOI, F

ART UNIT	PAPER NUMBER
1616	3

DATE MAILED: 08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application N .

09/766,513

Applicant(s)

PATTERSON ET AL.

Examiner

Frank I Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

The attempt to incorporate subject matter into this application by reference to a U.S. Patent is improper because no application number, U.S. patent number or even an attorney docket number is given.

The disclosure is objected to because of the following informalities:

The Specification contains blank spaces where a U.S. Patent number should be. Examiner notes that if Applicant fills in said blank spaces, new matter issues will have to be addressed.

Claims 2-4, 6, 8-10, 12, 13 are objected to because of the following informalities:

Dependent claims should begin with a "The" not an "A".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3, 4, 9,13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "gum aerobic". There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "all soluble gums" which render the claim indefinite as it is uncertain how a compound can contain "all soluble gums".

Claims 3, 9, 13 recite the phrase "taken from the group that includes" which renders the claim indefinite as it creates an open Markush group of which the other members are not known, whereas, a Markush group is supposed to be closed. Examiner suggests using "selected from the group consisting of".

Claim 4 recites "includes : . . . as said oxyacid salt; . . . as an acidic inorganic salt" without using "and" or "or", as such, it is uncertain whether the cation exchange material is supposed to contain both salts or either salt.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-9, 11-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,187,347

(Patterson et al.) in view of Leveen et al (U.S. Pat. 4,113,851), Burgeni et al. (U.S. Pat. 3,187,747), Eberl et al. (U.S. Pat. 2,688,586) and Masci et al. (U.S. Pat. 2,772,999).

Patterson et al. claims a method of arresting blood flow and a method of promoting healing of a bleeding wound by applying a substantially anhydrous compound of a salt ferrate which can be combined with an ion exchange resin (Claims 1-28).

Leveen et al. teach that polymer acids, such as polyacrylic acid, and cation exchange resins donate acidity to the wound being treated by releasing hydrogen ions (See entire document, especially column 1, lines 45-56, column 3, lines 65-69, column 4, lines 1-52).

Burgeni et al. teach that examples of polymers having acidifying properties include polyacrylic acid, alginic acid and cellulose derivatives, such as carboxy methyl cellulose, which have cation exchange properties (See entire document, especially, column 4, lines 6-44).

Eberl et al. teach that alginic acid causes blood to coagulate (See entire document, especially, column 1, lines 53-60, column 2, lines 1-14).

Masci et al. teach that free acid cellulose glycolic acid ethers, i.e. free acid carboxy methyl cellulose, and free acid cellulose hydroxypropionic acid ethers cause blood to congeal (See entire document, especially, column 2, lines 5-34).

The difference between the claims of Patterson et al. and the claimed invention is that Patterson et al. does not claim a hydrophilic proton donor or polymer. However, the same is amply suggested by the prior art as the same are well known in the art. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to use the same with the expectation that there use would add to the hemostatic properties of the product.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claims of U.S. Pat. 6,187,347 to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Claim Rejections - 35 USC § 103

Claims 1, 2, 5-9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. (U.S. Pat. 2,491,416) in view of Leveen et al., Burgeni et al., Eberl et al. and Masci et al.

Olson et al. teach the combination of tantalum oxide and iron oxide for stopping bleeding of wounds and that the powder can be moistened with liquid agents (Columns 1-3, Column 4, lines 28-36).

Leveen et al., Burgeni et al., Eberl et al. and Masci et al. are cited here for the same reasons as above and incorporated herein to avoid repetition.

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the use of an oxyacid salt in combination with an ion exchange resin, hydrophilic proton donor or hydrophilic polymer. However, the prior art amply suggests the same as tantalum and iron oxide for stopping blood flow and ion exchange resins, hydrophilic proton donors and hydrophilic polymers are known in the art. As such, it would have been well within the skill of and one of ordinary skill in the art would have expected that salts of iron oxide would also be as effective in stopping the blood flow and that the combination of the polymers would add to the hemostatic properties of the product.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
- (f) he did not himself invent the subject matter sought to be patented.

Claims 1-3 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter and under 35 U.S.C. 102(e) as being anticipated Patterson et al. (U.S. Pat. 6,187,347).

. Patterson et al. (U.S. 6,187,347) which is a different inventive entity than the inventive entity of the present application expressly discloses a substantially anhydrous salt ferrate compound, such as $K_2 Fe O_4$, combined with an effective amount of an insoluble cation exchange resin (See Column 7, lines 35-63, Claims 1-28) which falls within the scope of Claims 1-3 of the present Application

Conclusion


A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

FIC

July 30, 2001


JOHN PAK
PRIMARY EXAMINER
GROUP 1000

